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Sheldon Kasower

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EXAMINER

FIELDS, BENJAMIN S

ART UNIT

PAPER NUMBER

3692

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/724,315	Applicant(s) KASOWER, SHELDON	
	Examiner BENJAMIN S. FIELDS	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,8,22-29,31-33,35 and 37-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,8,22-29,31-33,35 and 37-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2 March 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. A **request for continued examination** under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), **was filed** in this application **after final rejection**. Since this application is **eligible** for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the **finality** of the previous Office action has been **withdrawn** pursuant to 37 CFR 1.114. Applicant's submission filed on 5 June 2009 has been entered.

2. The following is a **NON-FINAL** Office Action in response to the communication received on 5 June 2009. Claims 1, 3-4, 8, 22-29, 31-33, 35, and 37-40 are now pending in this application.

Response to Amendments

3. Applicant's Amendments to Claims 1-4, 8, 18, and 22-36 has been acknowledged in that: **Claims 2, 18-21, 30, 34, and 36 have been newly cancelled; Claims 1, 3, 26, and 35 have been newly amended; Claims 37-40 have been newly added**; hence, as such, **Claims 1, 3-4, 8, 22-29, 31-33, 35, and 37-40 are pending in this application**.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims **1, 3-4, 8, 22-25, 37, and 40** are rejected under 35 U.S.C. 101 because the claimed invention is not directed to a secondary statutory subject matter/class.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. In this particular case, Claims **1, 3-4, 8, 22-25, 37, and 40** are not tied to another statutory class, such as any hardware. Thus, it is unclear as to whether or not the claims are mere processes that involve purely human labor.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion *Ex parte Langemyer et al.*:

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http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-4, 8, 22-29, 31-33, 35, and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazerson (US Pat. No. 7,366,694), [hereinafter Lazerson] in view of Stanfield (US PG. Pub. No. 2008/0133278), [hereinafter Stanfield].

Referring to Claim 1: Lazerson teaches a method of preserving an individual's access to credit by means of a service organization comprising: obtaining authorization from the individual to contact and obtain dynamic credit information from a credit reporting bureau ; using one or more computer processing units, on a periodic basis accessing dynamic credit information of the individual from the credit reporting bureau report and deriving debt data from the credit information comprising (Lazerson: Abstract; See Figures; Column 2, Line 35-Column 4, Line 65): contacting the credit reporting bureau and obtaining dynamic credit information, and deriving debt data for a credit card debt category and for each of a plurality of other debt categories from the

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dynamic credit information; using one or more computer processing units, on a periodic basis determining the amount necessary to provide debt payment coverage based on the debt data derived from the credit information (Lazerson: Abstract; See Figures; See Claims), comprising: presenting information to the individual which classifies the debt data for the credit card debt category and for each of the plurality of debt categories.

Lazerson, however, does not expressly discuss the debt data to be used in determining an amount necessary to provide coverage for aggregated insurance benefits; and allowing the individual to select among the credit card debt category and the other debt categories for which the individual will obtain the aggregated insurance benefits; using one or more computer processing units, selecting a specific insurance company to provide coverage for the aggregated insurance benefits based on the amount necessary to provide debt payment coverage at specific aggregated insurance premiums.

Stanfield, in a similar environment, shows the debt data to be used in determining an amount necessary to provide coverage for aggregated insurance benefits; and allowing the individual to select among the credit card debt category and the other debt categories for which the individual will obtain the aggregated insurance benefits; using one or more computer processing units, selecting a specific insurance company to provide coverage for the aggregated insurance benefits based on the amount necessary to provide debt payment coverage at specific aggregated insurance premiums (Stanfield: Abstract; See Figures; Page 1, Paragraphs 0002-0012; Page 1, Paragraph 0017-Page 2, Paragraph 0024).

At the time of invention it would have been obvious to one of ordinary skill in the art to modify the method and system of Stanfield for a method and system for providing multi-credit card insurance with the features of Lazerson for credit/financing processes for the purpose of assisting borrowers avoid predatory lending and unjustified credit/financing rates, etc. (Lazerson: Column 1, Lines 19-63).

Referring to Claim 3: Lazerson shows a method further comprising on a periodic basis adjusting the value of the determined amount necessary to provide coverage for the aggregated insurance benefits in accordance with the changes in the data derived from the credit information (Lazerson: Column 2, Line 35-Column 4, Line 65; Column 5, Line 15-Column 7, Line 63).

Referring to Claim 4: Stanfield teaches a method further comprising on a periodic basis, updating the database to include any new insurance companies and to update the premiums that the one or more insurance companies charge for providing their aggregated insurance benefits (Stanfield: Abstract; See Figures; Page 1, Paragraphs 0002-0012; Page 1, Paragraph 0017-Page 2, Paragraph 0029; See Claims).

Referring to Claim 8: Stanfield discusses a method further comprising on a periodic basis, determining any change in the amount necessary to provide debt payment coverage and adjusting the value of the premiums owed by the individual in accordance with the changes in the data derived from the credit information (Stanfield: Abstract; See Figures; Page 1, Paragraphs 0002-0012; Page 1, Paragraph 0017-Page 2, Paragraph 0024).

Referring to Claim 22: Stanfield shows a method further comprising registering the individual with the service organization (Stanfield: Abstract; See Figures; See Claims).

Referring to Claim 23: Stanfield discloses a method further comprising entering a database including one or more insurance companies that provide the insurance coverage benefits, the database further including the specific premiums that the one or more insurance companies charge for issuing their aggregated insurance benefits (Stanfield: Page 1, Paragraphs 0002-0012; Page 1, Paragraph 0017-Page 2, Paragraph 0029; Page 3, Paragraph 0037-Page 4, Paragraph 0042).

Referring to Claim 24: Stanfield teaches a method further comprising on a periodic basis informing the individual of the specific premiums (Stanfield: Abstract; See Figures; See Claims).

Referring to Claim 25: Stanfield shows a method further comprising requesting that the insurance company provide coverage for the existing aggregated insurance benefits to the individual (Stanfield: Abstract; See Figures; Page 1, Paragraphs 0002-0012; Page 1, Paragraph 0017-Page 2, Paragraph 0029; Page 3, Paragraph 0037-Page 4, Paragraph 0042; See Claims).

Referring to Claims 26-29 and 31-33: Claims 26-29 and 31-33 are directed towards a computer program product for carrying out/implementing the method steps of Claims 1, 3-4, 8, and 22-25. As such, Claims 26-29 and 31-33 are rejected under the same basis as are Claims 1, 3-4, 8, and 22-25 as mentioned supra.

Referring to Claim 35: Claim 35 parallels a system for the method of Claims 1, 3-4, 8, and 22-25. As such, Claim 35 is rejected under the same basis as are Claims 1, 3-4, 8, and 22-25 as mentioned supra.

Referring to Claim 37: Lazerson discloses a method wherein the plurality of other debt categories include a mortgage loan debt category and/or an auto loan debt category (Lazerson: Abstract; Claims 1-5).

Referring to Claim 38: Lazerson shows a computer program product wherein the plurality of other debt categories include a mortgage loan debt category and/or an auto loan debt category (Lazerson: Abstract; Claims 1-5).

Referring to Claim 39: Claim 39 reflects a system for the method of Claim 37. As such, Claim 39 is rejected under the same basis as is Claim 37 as mentioned supra.

Referring to Claim 40: The Examiner notes that it is old and notoriously well known that method wherein the specific insurance company selected to provide coverage for the aggregated insurance benefits is selected based on the state where the individual lives is a common practice amongst both individuals and insurance agents/companies/organizations.

Response to Arguments

8. Applicant's arguments filed 5 June 2009 have been fully considered but have been found to be **moot** and **non-persuasive**. The Applicant argues:

Argument

§ 103 Rejections

The combination of Lazerson and Stanfield does not teach or suggest these features. First, nowhere does Lazerson or Stanfield teach or suggest, obtaining authorization from the individual to contact and obtain dynamic credit information from a credit reporting bureau. Neither Lazerson nor Stanfield suggests obtaining authorization from an individual to contact and obtain dynamic credit information from a credit reporting bureau. Lazerson only teaches receiving credit and financial information from the borrower - not a credit reporting bureau (see column 2, lines 50-51 of Lazerson). Also, Lazerson merely teaches requiring authorization from an individual to share credit information to financial institutions and not to, contact and obtain credit information from a credit reporting bureau, as recited in claim 1 (see column 2, lines 4-14 of Lazerson). Moreover, Stanfield is silent as to obtaining authorization from the individual to contact and obtain dynamic credit information from a credit reporting bureau. Second, nowhere does Lazerson or Stanfield teach or suggest, on a periodic basis, contacting the credit reporting bureau and obtaining dynamic credit information. The rejection relies on column 7, lines 38-63 of Lazerson for teaching accessing credit information of an individual from a credit reporting bureau and deriving debt data from the credit information. However, this portion of Lazerson merely states that "within this mortgage credit granting system, there is opportunity for providing future reminders or information on the borrowers' credit report and credit scores". Lazerson does not teach from where the information on the borrowers' credit report and credit scores are obtained. In fact, as stated above, Lazerson only teaches receiving credit and financial information from the borrower - not a credit reporting bureau (see column 2, lines 50-51 of Lazerson), and coordinating among creditors and major credit bureaus to correctly portray outstanding balances, public records items, tax liens, judgments, etc. (see column 4, lines 23-29). Stanfield does not overcome these deficiencies of Stanfield. Stanfield

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teaches that credit information is obtained from databases 20a-20c that represent information from credit bureaus, but does not teach or suggest how the credit information is obtained from the credit bureau (see paragraph [0027] of Stanfield). Thus, Stanfield does not teach or suggest contacting a credit reporting bureau, as recited in claim 1. Third, nowhere does Lazerson or Stanfield teach or suggest deriving debt data for a credit card debt category and for each of a plurality of other debt categories from dynamic credit information obtained from a credit reporting bureau, the debt data to be used in determining an amount necessary to provide coverage for aggregated insurance benefits. Lazerson is merely directed to a credit/financing process that allows a borrower to anonymously obtain and/or evaluate desired financial services from different lenders (see the Abstract and column 2, line 35-column 4, line 65 of Lazerson). Thus, Lazerson is not directed to a process for obtaining aggregated insurance benefits and is therefore not interested in deriving debt data for a credit card debt category and for each of a plurality of other debt categories to be used in determining an amount necessary to provide coverage for aggregated insurance benefits. Stanfield also does not teach or suggest deriving debt data for a credit card debt category and for each of a plurality of other debt categories from dynamic credit information obtained from a credit reporting bureau, the debt data to be used in determining an amount necessary to provide coverage for aggregated insurance benefits. In contrast, Stanfield is only interested in obtaining data regarding balances for a plurality of different credit cards. In contrast, claim 1 is directed at deriving debt data not only for a credit card debt category, but also for each of a plurality of other debt categories. Nowhere does Stanfield contemplate deriving debt data for a credit card debt category and a plurality of other debt categories, as required by claim 1. Fourth, nowhere does Lazerson or Stanfield teach or suggest presenting information to the individual which classifies the debt data for the credit card debt category and for each of the plurality of other debt categories, and allowing the individual to select among the credit card debt category and the plurality of other debt categories for which the individual will obtain the aggregated insurance benefits. As discussed above, Lazerson is merely directed to a credit/financing process that allows a borrower to anonymously obtain and/or evaluate

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desired financial services from different lenders and does not contemplate the above features of claim 1. Also, as Stanfield does not contemplate deriving debt data for a credit card debt category and a plurality of other debt categories, Stanfield also cannot contemplate presenting information to the individual which classifies the debt data for the credit card debt category and for each of the plurality of other debt categories. Further, nowhere does Stanfield teach or suggest allowing the individual to select among the credit card debt category and the plurality of other debt categories for which the individual will obtain the aggregated insurance benefits. Stanfield merely teaches a method that determines when the individual has added or deleted credit cards and obtains credit information and determines insurance premiums for all of the existing credit cards. In contrast, claim 1 allows the individual to select among the credit card debt category and the plurality of other debt categories for which the individual will obtain the aggregated insurance benefits. For at least these reasons claim 1 is not suggested by the combination of Lazerson and Stanfield and should be allowed. Claims 3, 4, 8, 22-25, 37, 40 and 41 depend from claim 1 and should be allowed for at least the same reasons. With respect to claim 23, nowhere does the combination of Lazerson and Stanfield teach or suggest entering a database including one or more insurance companies that provide the insurance coverage benefits, the database further including the specific premiums that the one or more insurance companies charge for issuing their aggregated insurance benefits. Neither Lazerson nor Stanfield teaches or suggests these features. For at least these reasons claim 23 should be allowed. Claims 26 and 35 are rejected for the same reasons as claim 1. Thus, for at least the same reasons discussed above with respect to claim 1, nowhere does the combination of Lazerson and Stanfield teach or suggest the similar features of claims 26 and 35. Claims 27-29, 31-33 and 38 depend from claim 26 and should be allowed for at least the same reasons. Also, claim 39 depends from claim 35 and should be allowed for at least the same reasons.

Regarding Argument

The Examiner respectfully disagrees. First, Stanfield does teach or suggest, obtaining authorization from the individual to contact and obtain dynamic credit information from a credit reporting bureau (See Stanfield at least at Figures 1[10], 2; Paragraphs 0026-0027, 0033-0035; Claim 10). Here, Stanfield suggests obtaining authorization from an individual to contact and obtain dynamic credit information from a credit reporting bureau. While Lazerson may only teach receiving credit and financial information from the borrower (per Applicant), it is understood (from one of ordinary skill in the art) that such credit and financial data is received by a credit reporting bureau (See Lazerson at least at Column 2, Lines 50-61). Per Applicant, if Lazerson merely teaches requiring authorization from an individual to share credit information to financial institutions and not to, contact and obtain credit information from a credit reporting bureau, one of ordinary skill in the art, would understand that such a step of contacting and obtaining credit information from a credit reporting bureau would be paramount to this step as recited in Claim 1 of the instant application.

Lazerson indeed teaches and suggests, on a periodic basis accessing credit information of an individual from a credit reporting bureau and deriving debt data from the credit information as required by claim 1. See at least (Lazerson: Abstract; Column 7, Lines 38-64). Also, Lazerson shows, on a periodic basis determining an amount necessary to provide debt payment coverage (See at least Lazerson: Abstract; Column 2, Lines 33-47; Column 4, Lines 6-65; Column 7, Lines 38-64) based on the data derived from the credit information (See at least Lazerson: Claims 9, 19).

Furthermore, Stanfield does disclose processes for selecting an insurance company to provide coverage for aggregated insurance benefits.

The rejection relies on column 7, lines 38-63 of Lazerson for teaching accessing credit information of an individual from a credit reporting bureau and deriving debt data from the credit information.

9. Any additional arguments filed 5 June 2009 have been fully considered but have been found to be **moot** and **non-persuasive**. Additionally, as the remaining claims depend directly or indirectly from the independent claims mentioned/discusses above, the Examiner maintains all previously asserted rejections.

Conclusion

10. Any inquiry concerning this communication should be directed to BENJAMIN S. FIELDS at telephone number 571.272.9734. The examiner can normally be reached MONDAY THRU FRI between the hours of 9AM and 7PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KAMBIZ ABDI can be reached at 571.272.6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin S. Fields

17 July 2009

/Harish T Dass/

Primary Examiner, Art Unit 3692